

Xerox Docket No. D/A1201

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE HONORABLE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the Application of

Victoria M. BELLOTTI et al.

On Appeal from Group: 2145

Application No.: 09/683,532

Examiner: A. CHOUDHURY

Filed: January 16, 2002

Docket No.: 110143

For: SYSTEMS AND METHODS FOR INTEGRATING ELECTRONIC MAIL AND  
DISTRIBUTED NETWORKS INTO A WORKFLOW SYSTEM

APPEAL BRIEF TRANSMITTAL

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Attached hereto is our Brief on Appeal in the above-identified application.

The Commissioner is hereby authorized to charge Deposit Account No. 24-0037 in the amount of Five Hundred Dollars (\$500.00) in payment of the Brief fee under 37 C.F.R. 41.20((b)(2)). In the event of any underpayment or overpayment, please debit or credit our Deposit Account No. 24-0037 as needed in order to effect proper filing of this Brief.

For the convenience of the Finance Division, two additional copies of this transmittal letter are attached.

Respectfully submitted,

James A. Oliff  
Registration No. 27,075

J. Adam Neff  
Registration No. 41,218

JAO:JAN/scg  
Date: February 28, 2006

OLIFF & BERRIDGE, PLC  
P.O. Box 19928  
Alexandria, Virginia 22320  
Telephone: (703) 836-6400

DEPOSIT ACCOUNT USE  
AUTHORIZATION  
Please grant any extension  
necessary for entry;  
Charge any fee due to our  
Deposit Account No. 24-0037



PATENT APPLICATION

Xerox Docket No. D/A1201

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE HONORABLE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the Application of

Victoria M. BELLOTTI et al.

Application No.: 09/683,532

Examiner: A. CHOUDHURY

Filed: January 16, 2002

Docket No.: 110143

For: SYSTEMS AND METHODS FOR INTEGRATING ELECTRONIC MAIL AND  
DISTRIBUTED NETWORKS INTO A WORKFLOW SYSTEM

BRIEF ON APPEAL

03/01/2006 SZENDIE1 00000193 240037 09683532

01 FC:1402 500.00 DA

Appeal from Group 2145

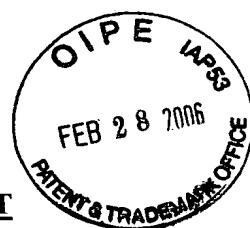
OLIFF & BERRIDGE, PLC  
P.O. Box 19928  
Alexandria, Virginia 22320  
Telephone: (703) 836-6400  
Attorneys for Appellants



TABLE OF CONTENTS

	<u>Page</u>
I. REAL PARTY IN INTEREST .....	1
II. STATEMENT OF RELATED APPEALS AND INTERFERENCES.....	2
III. STATUS OF CLAIMS .....	3
IV. STATUS OF AMENDMENTS.....	4
V. SUMMARY OF CLAIMED SUBJECT MATTER .....	5
VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL.....	8
VII. ARGUMENT.....	9
A. Independent Claims 1 and 10 .....	9
1. Even If Combined, Sakaguchi And Paul Would Not Have Resulted In A Method In Which A Link Embedded In An E-Mail Provides A Recipient, Who Does Not Have Access To A Work Flow System, With An Access To The Associated Process Of The Workflow System.....	9
2. The Examiner's Analysis Is Based On The Incorrect Assumption That Sakaguchi's "Workflow Definitions" Are "Equivalent To The Claimed Network Addresses" .....	11
3. The Office Action Fails To Establish Proper Motivation To Combine The References .....	12
B. Dependent Claims 2 and 11 .....	12
C. Dependent Claims 3 and 12.....	13
D. Dependent Claims 4 and 13.....	13
E. Dependent Claims 5 and 14.....	14
F. Dependent Claims 8 and 17-19 .....	14
G. Dependent Claims 9 and 20.....	15
H. Independent Claim 21 .....	15
1. The Examiner's Theory Of Inherency Is Unsupported .....	15
2. The Examiner's Analysis Is Based On The Incorrect Assumption That Sakaguchi's "Workflow Definitions" Are "Equivalent To The Claimed Network Addresses" .....	16

3. The Office Action Fails To Establish Proper Motivation To Combine The References .....	16
I. Dependent Claim 22 .....	17
J. Independent Claim 23 .....	18
1. Even If Combined, Sakaguchi And Paul Would Not Have Resulted In A Method Including Determining If A User Is A Valid User, And Providing Access To A Workflow Process Only If The User Is Determined To Be A Valid User .....	18
2. The Examiner's Analysis Is Based On The Incorrect Assumption That Sakaguchi's "Workflow Definitions" Are "Equivalent To The Claimed Network Addresses" .....	19
3. The Office Action Fails To Establish Proper Motivation To Combine The References .....	19
K. Dependent Claim 24 .....	20
L. Dependent Claim 25 .....	21
VIII. CONCLUSION.....	21
APPENDIX A - CLAIMS APPENDIX.....	A-1
APPENDIX B - EVIDENCE APPENDIX .....	B-1
APPENDIX C - RELATED PROCEEDINGS APPENDIX .....	C-1



Xerox Docket No. D/A1201  
Application No. 09/683,532

**I. REAL PARTY IN INTEREST**

The real party in interest for this appeal and the present application is Xerox Corporation, by way of an Assignment recorded in the U.S. Patent and Trademark Office at Reel 012311, Frame 0191.

**II. STATEMENT OF RELATED APPEALS AND INTERFERENCES**

There are no prior or pending appeals, interferences or judicial proceedings, known to Appellant, Appellant's representative, or the Assignee, that may be related to, or which will directly affect or be directly affected by or have a bearing upon the Board's decision in the pending appeal.

**III. STATUS OF CLAIMS**

Claims 1-25 are on appeal.

Claims 1-25 are pending.

Claims 1-25 are rejected.

**IV. STATUS OF AMENDMENTS**

No Amendment After Final Rejection has been filed.

**V. SUMMARY OF CLAIMED SUBJECT MATTER**

A. The invention of claim 1 is directed to a method for transmitting a workflow-enabled electronic mail message from a user of a workflow system (e.g., the workflow system 200 shown in Fig. 1) to a recipient (e.g., the recipient device 400 shown in Fig. 1). As shown in Fig. 1 and described at, for example, paragraphs [0005], [0013] and [0068], the recipient does not have access to the workflow system. The method comprises:

creating an email message to the recipient by the user, the recipient who does not have access to the workflow system (see, e.g., Fig. 5, step S110 and the specification at [0074]);

determining a network address (see, e.g., Fig. 5, step S120 and the specification at [0074]);

embedding a link to the determined network address in the email message to the recipient (see, e.g., Fig. 5, step S130 and the specification at [0074]);

associating a process of the workflow system with the determined network address (see, e.g., the specification at [0101]); and

sending the email message having the link to the determined network address to the recipient (see, e.g., Fig. 5, step S140 and the specification at [0074]), wherein the link provides the recipient with an access to the associated process of the workflow system (see, e.g., the specification at [0009] and [0061]).

B. The invention of claim 10 is directed to a method for transmitting a workflow-enabled electronic mail message from a user of a workflow system (e.g., the workflow system 200 shown in Fig. 1) to a recipient (e.g., the recipient device 400 shown in Fig. 1). As shown in Fig. 1 and described at, for example, paragraphs [0005], [0013] and [0068], the recipient does not have access to the workflow system. The method comprises:

creating an email message to the recipient by the user, the recipient who does not have access to the workflow system (see, e.g., Fig. 7, step S310 and the specification at [0080]);

determining an email response address (see, e.g., Fig. 7, step S320 and the specification at [0080]);

incorporating the determined email response address into the email message to the recipient (see, e.g., Fig. 7, step S330 and the specification at [0080]);

associating a process of the workflow system with the determined email response address (see, e.g., the specification at [0101]); and

sending the email message having the incorporated email response address to the recipient (see, e.g., Fig. 7, step S340 and the specification at [0080]), wherein the incorporated email response address provides the recipient with an access to the associated process of the workflow system (see, e.g., the specification at [0009] and [0061]).

C. The invention of claim 21 is directed to a method for accessing a workflow process using a workflow-enabled email message, comprising:

receiving the workflow-enabled email message that includes a link to a network address associated with the workflow process, wherein the network address is specific to the workflow process and to the email message (see, e.g., Fig. 10, steps S610, S640 and S660 and the specification at [0088]-[0090]; see also, e.g., Fig. 6, steps S210 and S220 and the specification at [0077] - [0079]);

selecting the link to access the network address, wherein, in response, the workflow system provides access to the workflow process (see, e.g., Fig. 10, steps S640 and S660 and the specification at [0088]-[0090]; see also, e.g., Fig. 6, steps S210 and S270 and the specification at [0077] - [0079]).

D. The invention of claim 23 is directed to a method for providing access to a workflow process in response to receiving a network address that is associated with the workflow process, comprising:

receiving the network address from a user (see, e.g., Fig. 8, steps S405, S410 and the specification at [0081]);

determining if the user from which the network address is received is a valid user of that network address (see, e.g., Fig. 8, step S430 and the specification at [0083]); and

providing access to the user to the workflow process only if the user from which the network address is received is determined to be a valid user of that network address (see, e.g., Fig. 8, step S445 and the specification at [0083] - [0084]).

**VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

The following grounds of rejection are presented for review:

- 1) Claims 1-25 are rejected under 35 U.S.C. §103(a) over U.S. Patent No. 6,594,636 to Sakaguchi et al. ("Sakaguchi") in view of U.S. patent Application Publication No. US 2002/0169835 A1 to Paul, Jr. et al. ("Paul").

## **VII. ARGUMENT**

Contrary to the Examiner's assertions, claims 1-25 would not have been obvious over Sakaguchi in view of Paul. As demonstrated below, the Examiner has not established a *prima facie* case of obviousness, and the rejection is in error and should be reversed.

### **A. Independent Claims 1 and 10**

**1. Even If Combined, Sakaguchi And Paul Would Not Have Resulted In A Method In Which A Link Embedded In An E-Mail Provides A Recipient, Who Does Not Have Access To A Work Flow System, With An Access To The Associated Process Of The Workflow System**

---

The invention of claims 1 and 10 allows a recipient, who does not have access to a workflow system, to gain access to an associated process of the workflow system by using a link embedded in an e-mail. For example, as described in paragraph [0013], documentation requiring the approval of a person who does not have access to the workflow system may be sent via an electronic mail message with a network address generated by the system and inserted into the body of the message. By activating the network address in the body of the message, the recipient is able to access the specific location within the workflow system that stores the appropriate documentation requiring approval.

Neither Sakaguchi nor Paul discloses such a concept. Sakaguchi assumes that all relevant users have access to the workflow system, and simply does not disclose or suggest that a recipient who does not have access to the system could gain access by receiving an e-mail with an embedded link.

The Examiner's only response to this argument is to assert that "it is obvious to one skilled in the art that a link in an email allows an email recipient to access data, even data that may not have been accessible otherwise," and that "links provide an access to data to the recipient whereas without the link the recipient would not have had access to that data" (see the August 25, 2005 Office Action and the subsequent Advisory Action). These statements

are pure conclusion, and are not supported by any evidence. The Examiner does not even point to any specific teaching in either applied reference that would tend to even suggest such concept, much less any teaching that would suggest application of this concept to the Sakaguchi system. Furthermore, as discussed below, it is not inherent, or even likely, that "without the link the recipient would not have had access to that data" in the context of the prior art.

It is not disputed that the general art of embedding links in e-mail is known. However, these known embedded links are simply, e.g., convenient links to websites that the e-mail recipient could have accessed anyway. For example, it is known for user A to send recipient B an e-mail with an embedded link, with a message saying "click on this link to visit website Z." However, recipient B could have accessed website Z anyway, even without the embedded link, by typing in the appropriate website address on a web browser, for example. The embedded link is merely a convenience.

Paul, relied on by the Examiner for a teaching of embedding a link, appears to disclose no more than this. In other words, it appears that the embedded links disclosed in Paul provide more convenient access to websites that the recipient could have accessed anyway via the open Internet. (Paul appears to disclose "private access" in some parts of a system; however, this private access does not appear to be enabled by a link embedded in an e-mail. Paul's embedded links are in a different context.)

The Examiner apparently is relying on a theory of inherency in his assertion that "without the link the recipient would not have had access to that data," but he clearly has not met the burden of proving inherency (e.g., by providing explicit evidence or technical reasoning) that is set forth in MPEP §2112.IV.

Because neither Sakaguchi nor Paul discloses embedding, in an e-mail, a link that provides an e-mail recipient, who does not have access to a workflow system, with an access

to an associated process of the system, the two references would not, even if combined, include such a feature.

**2. The Examiner's Analysis Is Based On The Incorrect Assumption That Sakaguchi's "Workflow Definitions" Are "Equivalent To The Claimed Network Addresses"**

At page 3, lines 2-4 of the August 25, 2005 Office Action, the Examiner refers to the workflow definitions described in Sakaguchi, and states, without further analysis, that "definitions define the work to be flowed and include the claimed network addresses within them, hence workflow definitions are equivalent to the claimed network addresses." As discussed in more detail below, this statement (1) is illogical on its face, (2) is factually incorrect and (3) fails to address the recitation of "email response address" in claim 10.

First, even if Sakaguchi's workflow definitions did include network addresses, it is not logical to then say that workflow definitions are "equivalent" to network addresses. For example, a car may include a wheel, but it is not logical to say that a car is equivalent to a wheel.

Second, the Examiner has not explained the basis for his belief that workflow definitions include network addresses. In fact, the evidence seems to suggest otherwise. Specifically, Sakaguchi's workflow definitions are stored in a workflow definition storage unit 112 (see Fig. 1). At col. 5, lines 21-42, Sakaguchi describes a workflow definition that is shown in Fig. 5. There is no mention of a network address in Fig. 5 or the associated description.

Third, while claim 1 recites a "network address," claim 10 does not recite "network address" but instead recites "email response address." An example of this feature is described at [0080] in the specification. The Examiner fails to address this different claim language.

**3. The Office Action Fails To Establish Proper Motivation To Combine The References**

The Office Action asserts that it would have been obvious to combine the references "to provide an e-mail communications system, method and computer program." This alleged motivation is clearly inadequate.

First, Sakaguchi already appears to disclose an "e-mail communication system, method and computer program." Thus, if that were the goal, then Sakaguchi would need no modification to achieve that goal.

Second, there simply is no evidence that one of ordinary skill in the art would have recognized a general teaching of embedding a hyperlink, as taught by Paul, to be applicable or useful in the context of Sakaguchi. The absence of any teaching of an advantage of the Paul hyperlink in a context such as is disclosed by Sakaguchi is evidence that the Examiner has impermissibly relied on hindsight knowledge, gained from Applicants' disclosure, in formulating the rejection.

Third, the Examiner has failed to link the alleged motivation with the feature in question. The Examiner has simply cited a general object named in Paul (see paragraph [0004] of Paul), without considering whether the feature for which Paul is relied on (i.e., embedding a hyperlink) is tied to that object.

For at least these reasons, it is clear that the Examiner's attempt to establish motivation is without merit.

**B. Dependent Claims 2 and 11**

Claim 2 recites that "determining the network address comprises selecting the network address from a list of predefined network addresses." Claim 11 is similar, but refers to the email response address of claim 10. Examples of these features are described at [0046] and [0058] of the specification.

The Examiner asserts that Sakaguchi's workflow definitions are selectable from a list, and that this meets the claim language. However, as discussed above, Sakaguchi's workflow definitions are not network addresses or email response addresses. For at least this reason, the Examiner's analysis fails again with respect to claims 2 and 11.

**C. Dependent Claims 3 and 12**

Claim 3 recites that "determining the network address comprises generating the network address." Claim 12 is similar, but refers to the email response address of claim 10. Examples of these features are described at [0046] and [0058] of the specification.

The Examiner asserts that Sakaguchi's workflow definitions are "generated as claimed." However, as discussed above, Sakaguchi's workflow definitions are not network addresses or email response addresses. For at least this reason, the Examiner's analysis fails again with respect to claims 3 and 12.

**D. Dependent Claims 4 and 13**

Claim 4 recites that "generating the network address comprises randomly or pseudo-randomly generating the network address." Claim 13 is similar, but refers to the email response address of claim 10. Examples of these features are described at [0046] - [0047] and [0058] - [0060] of the specification. Some advantages of these features are described at, for example, [0061] and [0062].

The Examiner asserts that Sakaguchi discloses "pseudo-random" generation, "since nothing in computing is truly randomly performed." However, "randomly" and "pseudo-randomly" must be construed in light of the specification (e.g., [0060] - [0062]). The Examiner has failed to do so, and consequently has used an unreasonably broad interpretation. For at least this reason, the Examiner's analysis fails again with respect to claims 4 and 13.

**E. Dependent Claims 5 and 14**

Claim 5 recites that "generating the network address comprises generating the network address based on at least in part on information about at least one of at least the created email message, the recipient, the workflow process and the user." Claim 14 is similar, but refers to the email response address of claim 10. Examples of these features are described at [0060] of the specification.

The Examiner's analysis regarding claims 5 and 14 is unintelligible, stating simply that "Sakaguchi's design allows definitions to be derived from one or more definitions." From this statement, it is impossible to ascertain the basis for the Examiner's belief that Sakaguchi discloses generating an address based on information about a created email message, a recipient, a workflow process and/or a user. For at least this reason, the Examiner's analysis fails again with respect to claims 5 and 14.

**F. Dependent Claims 8 and 17-19**

Claims 8 and 17-19 recite various features that are described at, for example, [0072] of the specification. These claims should be construed in light of the specification (which it appears the Examiner has not done).

The Examiner dispenses with these claims by asserting that each feature recited therein is inherent in Sakaguchi. However, the Examiner clearly has not met his burden of proving inherency, which is set forth, e.g., in MPEP §2112.IV. (As a reminder, even the possibility that a feature is not necessarily present in a prior art device is sufficient to defeat an assertion of inherency.) The only attempt at technical reasoning is in the Examiner's statement that "if multiple network addresses are necessary in the workflow, these inherently must be present within the workflow definitions" (August 25, 2005 Office Action, page 9, item 8, second paragraph). This statement on its face appears to concede the possibility that multiple network addresses might not be necessary in the workflow according to Sakaguchi,

thus undercutting the assertion of inherency. Additionally, this statement utterly fails to address the subject matter of at least claims 17 and 18. For at least this additional reason, the Examiner's analysis fails with respect to claims 8 and 17-19.

**G. Dependent Claims 9 and 20**

Claim 9 recites that "associating a process of the workflow system with the determined network address comprises associating a different state of the associated process of the workflow system with each of the plurality of determined network addresses." Claim 20 is similar, but refers to the email response address of claim 10. Examples of these features are described at [0072] of the specification.

These claims should be construed in light of the specification (which it appears the Examiner has not done). As explained by way of example at [0072], a message sent to a recipient requesting acceptance or rejection of a workflow document may have a number of encoded email addresses, one each for acceptance and rejection. By clicking on the appropriate response, an email message is sent to the workflow system, which adjusts the workflow state accordingly.

The Examiner asserts, without evidence, that the features of claims 9 and 20 are inherent in Sakaguchi. Such unfounded assertions simply cannot support a rejection, especially not a rejection based on a theory of inherency.

**H. Independent Claim 21**

**1. The Examiner's Theory Of Inherency Is Unsupported**

At page 11, item 10, second paragraph of the August 25, 2005 Office Action, the Examiner asserts that:

Sakaguchi's workflow system is email based and hence the workflow definitions (network addresses) are sent by email. Being such, the email messages must be received as claimed and the workflow definitions (network addresses) must be used to access the state of the workflow process in need of attention by the recipient. The claimed traits are inherent within email based workflow systems.

Like the other assertions of inherency discussed above, this assertion is not supported by evidence or technical reasoning. Moreover, it is factually incorrect and/or circular.

First, it appears that Sakaguchi's workflow definitions are not emailed to anyone, but rather are selected for another purpose in a different context. See, e.g., Fig. 10, in which workflow definitions are selected at step 1004, and used as a basis for comparison in step 1005, but are not emailed to a recipient.

Second, it does not appear that the workflow definitions are "used to access the state of the workflow process in need of attention by the recipient," despite the Examiner's assertion to the contrary.

Thus, the features of claim 21 are not inherent in Sakaguchi (and Paul cannot change this fact).

**2. The Examiner's Analysis Is Based On The Incorrect Assumption That Sakaguchi's "Workflow Definitions" Are "Equivalent To The Claimed Network Addresses"**

As discussed above with respect to claims 1 and 10, the Examiner's assumption that Sakaguchi's workflow definitions are equivalent to the claimed network addresses (1) is illogical on its face and (2) is factually incorrect.

**3. The Office Action Fails To Establish Proper Motivation To Combine The References**

The Office Action asserts that it would have been obvious to combine the references "to provide an e-mail communications system, method and computer program." This alleged motivation is clearly inadequate.

First, Sakaguchi already appears to disclose an "e-mail communication system, method and computer program." Thus, if that were the goal, then Sakaguchi would need no modification to achieve that goal.

Second, there simply is no evidence that one of ordinary skill in the art would have recognized a general teaching of embedding a hyperlink, as taught by Paul, to be applicable

or useful in the context of Sakaguchi. The absence of any teaching of an advantage of the Paul hyperlink in a context such as is disclosed by Sakaguchi is evidence that the Examiner has impermissibly relied on hindsight knowledge, gained from Applicants' disclosure, in formulating the rejection.

Third, the Examiner has failed to link the alleged motivation with the feature in question. The Examiner has simply cited a general object named in Paul (see paragraph [0004] of Paul), without considering whether the feature for which Paul is relied on (i.e., embedding a hyperlink) is tied to that object.

For at least these reasons, it is clear that the Examiner's attempt to establish motivation is without merit.

### **I. Dependent Claim 22**

Claim 22 recites "receiving a request to provide authentication from the workflow system in response to selecting the link; and providing the requested authentication to the workflow system, the workflow system denying access to the workflow process if the requested authentication is not valid." This means that there is a possibility that an authentication attempt may fail, in which case the system denies access.

The Examiner asserts that Sakaguchi discloses such a feature, because "the workflow is only sent to the selected user and each user address is unique in the system ensuring authentication." In other words, because things are sent to the right user and each user is different, "authentication" is inherently performed. This analysis is clearly deficient.

As discussed above, the language of claim 22 means that there is a possibility that an authentication attempt may fail, in which case the system denies access. In contrast, according the Examiner's analysis, there is never even a chance for failure, because things are sent where they are supposed to be sent each time, and it is assumed that a designated recipient is authorized to receive what he or she has been sent. The Examiner's expansive

definition of "authentication" is not only inconsistent with Appellants' specification (and therefore unreasonable), but also flies in the face of any commonly accepted definition of "authentication."

For this additional reason, the rejection of claim 22 should be reversed. .

**J. Independent Claim 23**

**1. Even If Combined, Sakaguchi And Paul Would Not Have Resulted In A Method Including Determining If A User Is A Valid User, And Providing Access To A Workflow Process Only If The User Is Determined To Be A Valid User**

---

At page 13, item 12, second paragraph of the August 25, 2005 Office Action, the Examiner asserts that "determining if the user from which the network address is received is a valid user of that network address" is disclosed by Sakaguchi. This assertion appears to be based on the assumption that "emails [sic] systems require sign-in procedures to access emails." However, the Examiner's analysis is flawed.

First, it is respectfully noted that the passage of Sakaguchi referenced by the Examiner (col. 4, line 53--col. 5, line 8) says nothing about user identification. (Rather, it discusses assigning a unique identifier to each message.)

Second, it does not appear that the workflow definitions of Sakaguchi are "used to access the state of the workflow process in need of attention by the recipient," despite the Examiner's assertion to the contrary.

Third, the definition of "valid user" apparently used by the Examiner is overly broad, and is not supported by, or reasonable in view of, the specification. Under the Examiner's apparent definition, anyone who is able to log on to an email system to check their messages would be a valid user. This clearly is not what claim 23 means. Rather, it is clear from claim 23 that a user has sent a network address (not merely logged onto an e-mail account), and then a determination is made as to whether that user is a valid user. In contrast, under the

Examiner's theory, anyone who has been able to log on to an e-mail system is automatically a valid user. No "determination" needs to be made.

**2. The Examiner's Analysis Is Based On The Incorrect Assumption That Sakaguchi's "Workflow Definitions" Are "Equivalent To The Claimed Network Addresses"**

As discussed above with respect to claims 1 and 10, the Examiner's assumption that Sakaguchi's workflow definitions are equivalent to the claimed network addresses (1) is illogical on its face and (2) is factually incorrect.

**3. The Office Action Fails To Establish Proper Motivation To Combine The References**

The Office Action asserts that it would have been obvious to combine the references "to provide an e-mail communications system, method and computer program." This alleged motivation is clearly inadequate.

First, Sakaguchi already appears to disclose an "e-mail communication system, method and computer program." Thus, if that were the goal, then Sakaguchi would need no modification to achieve that goal.

Second, there simply is no evidence that one of ordinary skill in the art would have recognized a general teaching of embedding a hyperlink, as taught by Paul, to be applicable or useful in the context of Sakaguchi. The absence of any teaching of an advantage of the Paul hyperlink in a context such as is disclosed by Sakaguchi is evidence that the Examiner has impermissibly relied on hindsight knowledge, gained from Applicants' disclosure, in formulating the rejection.

Third, the Examiner has failed to link the alleged motivation with the feature in question. The Examiner has simply cited a general object named in Paul (see paragraph [0004] of Paul), without considering whether the feature for which Paul is relied on (i.e., embedding a hyperlink) is tied to that object.

For at least these reasons, it is clear that the Examiner's attempt to establish motivation is without merit.

**K. Dependent Claim 24**

Claim 24 recites that "determining if the user from which the network address is received is a valid user of that network address comprises comparing an email address provided by the user to an email address associated with the network address for the user."

The Examiner asserts that Sakaguchi discloses this concept at col. 4, line 53--col. 5, line 8. However, as discussed above in connection with claim 23, this passage says nothing about user identification. (Rather, it discusses assigning a unique identifier to each message.)

Additionally, the Examiner fails to address the "comparing" feature recited in claim 24.

**L. Dependent Claim 25**

Claim 25 recites that "determining the network address will not result in a single network address designated to different electronic messages."

The Examiner fails to address the claim language. The Examiner asserts that according to Sakaguchi, "different email messages will not be obtained," but this is not what claim 25 says.

Accordingly, it is clear that the Examiner has misconstrued the plain language of claim 25.

**VIII. CONCLUSION**

For all of the reasons discussed above, it is respectfully submitted that the rejections are in error and that claims 1-25 are in condition for allowance. For all of the above reasons, Appellants respectfully request this Honorable Board to reverse the rejection of claims 1-25.

Respectfully submitted,



James A. Oliff  
Registration No. 27,075

J. Adam Neff  
Registration No. 41,218

JAO:JAN/hs

OLIFF & BERRIDGE, PLC  
P.O. Box 19928  
Alexandria, Virginia 22320  
Telephone: (703) 836-6400

Filed: February 28, 2006



**APPENDIX A - CLAIMS APPENDIX**

**CLAIMS INVOLVED IN THE APPEAL:**

1. A method for transmitting a workflow-enabled electronic mail message from a user of a workflow system to a recipient, comprising:
  - creating an email message to the recipient by the user, the recipient who does not have access to the workflow system;
  - determining a network address;
  - embedding a link to the determined network address in the email message to the recipient;
  - associating a process of the workflow system with the determined network address; and
  - sending the email message having the link to the determined network address to the recipient, wherein the link provides the recipient with an access to the associated process of the workflow system.
2. The method of claim 1, wherein determining the network address comprises selecting the network address from a list of predefined network addresses.
3. The method of claim 1, wherein determining the network address comprises generating the network address.
4. The method of claim 3, wherein generating the network address comprises randomly or pseudo-randomly generating the network address.
5. The method of claim 3, wherein generating the network address comprises generating the network address based on at least in part on information about at least one of at least the created email message, the recipient, the workflow process and the user.
6. The method of claim 1, further comprising associating the determined network address with the email message.

7. The method of claim 6, wherein associating the determined network address with the email message comprises associating an email address of the recipient to which the created email will be sent with the determined network address.

8. The method of claim 1, wherein:

determining a network address comprises determining a plurality of different network addresses; and

embedding a link to the determined network address into the email message to the recipient comprises embedding a plurality of links into the email message, each link being to one of the plurality of determined network addresses.

9. The method of claim 8, wherein associating a process of the workflow system with the determined network address comprises associating a different state of the associated process of the workflow system with each of the plurality of determined network addresses.

10. A method for transmitting a workflow-enabled electronic mail message from a user of a workflow system to a recipient, comprising:

creating an email message to the recipient by the user, the recipient who does not have access to the workflow system;

determining an email response address;

incorporating the determined email response address into the email message to the recipient;

associating a process of the workflow system with the determined email response address; and

sending the email message having the incorporated email response address to the recipient, wherein the incorporated email response address provides the recipient with an access to the associated process of the workflow system.

11. The method of claim 10, wherein determining the email response address comprises selecting the email response address from a list of predefined email response addresses.

12. The method of claim 10, wherein determining the email response address comprises generating the email response address.

13. The method of claim 12, wherein generating the email response address comprises randomly or pseudo-randomly generating the email response address.

14. The method of claim 12, wherein generating the email response address comprises generating the email response address based on at least in part on information about at least one of at least the created email message, the recipient, the workflow process and the user.

15. The method of claim 10, further comprising associating the determined email response address with the email message.

16. The method of claim 15, wherein associating the determined email response address with the email message comprises associating an email address of the recipient to which the created email will be sent with the determined email response address.

17. The method of claim 10, wherein incorporating the determined email response address into the email message to the recipient comprises incorporating the determined email response address into a reply-to portion of the email message.

18. The method of claim 10, wherein incorporating the determined email response address into the email message to the recipient comprises incorporating the determined email response address into a selectable element of the email message.

19. The method of claim 10, wherein:  
determining an email response address comprises determining a plurality of different email response addresses; and

incorporating the determined email response address into the email message to the recipient comprises incorporating the plurality of determined email response addresses into the email message.

20. The method of claim 19, wherein associating a process of the workflow system with the determined email response address comprises associating a different state of the associated process of the workflow system with each of the plurality of determined email response addresses.

21. A method for accessing a workflow process using a workflow-enabled email message, comprising:

receiving the workflow-enabled email message that includes a link to a network address associated with the workflow process, wherein the network address is specific to the workflow process and to the email message;

selecting the link to access the network address, wherein, in response, the workflow system provides access to the workflow process.

22. The method of claim 21, further comprising:

receiving a request to provide authentication from the workflow system in response to selecting the link; and

providing the requested authentication to the workflow system, the workflow system denying access to the workflow process if the requested authentication is not valid.

23. A method for providing access to a workflow process in response to receiving a network address that is associated with the workflow process, comprising:

receiving the network address from a user;

determining if the user from which the network address is received is a valid user of that network address; and

providing access to the user to the workflow process only if the user from which the network address is received is determined to be a valid user of that network address.

24. The method of claim 23, wherein determining if the user from which the network address is received is a valid user of that network address comprises comparing an email address provided by the user to an email address associated with the network address for the user.

25. The method of claim 3, wherein determining the network address will not result in a single network address designated to different electronic messages.

**APPENDIX B - EVIDENCE APPENDIX**

A copy of each of the following items of evidence relied on by the Appellant [and/or the Examiner] is attached:

NONE

**APPENDIX C - RELATED PROCEEDINGS APPENDIX**

Copies of relevant decisions in the following related proceedings are attached:

NONE